

### REMARKS

Claims 1-13 and 22-36 are currently pending in the application.

Claim 8 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite because Applicant has not yet provided a copy of the procedure used to measure water vapor transmission rate.

Claims 1, 3-5, 11, 12, 22-27, and 31-35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946.

Claims 1, 3-5, and 11-12 stand rejected under 35 U.S.C. §102(e) as being anticipated by Gundberg et al. (U.S. Patent No. 6,203,646).

Claims 2, 8, and 30 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Jackson.

Claim 2 is further rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Gundberg et al.

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Penz et al. (U.S. Patent No. 5,888,913).

Claims 6-7 and 28-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson in further view of Penz et al.

Claims 9, 10, and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber et al. (U.S. Patent No. 4,898,892).

### Rejection of claim 8 under 35 U.S.C. §112, second paragraph

Applicant again acknowledges and accepts the Examiner's invitation to supply the requested information, and will do so upon receiving an indication of allowable subject matter.

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**Rejection of claims 1, 3-5, 11, 12, 22-27, and 31-35 under 35 U.S.C. §102(b)**

Claims 1, 3-5, 11, 12, 22-27, and 31-35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946.

Claim 1 describes a polymeric wall covering material having a thermoplastic coating applied to the non-woven fiber tissue or mat to provide a regular, roller paintable visible outer surface. This claim further requires that this regular, roller paintable surface is substantially free from random discontinuities susceptible to creating irregularities when the surface is roller painted. Independent claim 23 requires a polymeric wall covering material having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular, roller paintable visible outer surface, as well as a layer of paint "roller-applied." (Emphasis added).

In maintaining the rejections of these claims based on Jackson, the Examiner takes the position that "regular" is "synonymous to normal" and "implies lack of deviation from what has been discovered or established as the most usual or expected." (Office Action, ¶ 1(a), p. 2). In support of this meaning of "regular," the Examiner cites to Merriam-Webster's Collegiate Dictionary, Tenth Edition, page 985, which is not made of record. Without providing any further analysis of the teachings of Jackson or details as to why such is the case, the conclusion is reached that it "meets the recited limitation of being a regular surface." (Office Action, ¶ 1(a), p. 2). The Examiner also observes that the specification and claims "do not define the term 'regular' by any measurable mean so as to preclude the microscopic 'discontinuities' taught by Jackson." *Id.*

First addressing the chosen definition of "regular," precedential decisions make clear that "[i]ndiscriminate reliance should not be placed on layman's definitions found in dictionaries." <sup>1</sup> Rather, the Examiner "should look to the pertinent technology" in

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<sup>1</sup> *Ex parte Kumagai*, 9 USPQ2d 1642 (BPAI1988) (citing *In re Salem*, 533 F.2d 676, 193 USPQ 513, 518 (CCPA 1977) with approval and noting that "the lay definition of 'discrete' relied upon by the examiner does not even suggest its applicability to [this] technical area."); see also *Texas Digital Sys., Inc. v. Telegenix, Inc.*,

assessing the meaning of the terms used in the claims. One of ordinary skill in the materials science art would appreciate that a "regular" surface is "even," "smooth," or "uniform," rather than "normal" (which is a relative term). Applicant's understanding of the meaning of "regular" is entirely consistent with use of this term by others skilled in the materials sciences. For example, in U.S. Patent No. 6,407,016 to Van Steenlandt et al. as allowed by the present Examiner, the term "regular" is used to refer to a pattern. Using the Examiner's definition, this "pattern" would be "normal" or "lack . . . deviation from what has been discovered or established as the most usual or expected," which meaning makes no sense in this context because it is not clear what is usual or expected. Rather, the pattern described in the '016 patent is "even," "smooth" or "uniform," which is precisely the meaning that would be understood by a skilled artisan.

As the Examiner acknowledges, Jackson discloses a material having a surface with intentionally formed "randomly distributed discontinuities." These discontinuities are disadvantageous from the standpoint that they would more readily receive any paint roller-applied to the surface and magnify its imperfect, or "irregular" nature. Such a result is avoided by Applicant's claimed "regular," roller-paintable surface, which may for example be painted using a conventional roller. Indeed, to make the distinction abundantly clear, Applicant's claim 1 further requires that the "regular" surface is one substantially free from random discontinuities susceptible to creating irregularities when the surface is roller painted. Jackson therefore cannot anticipate this claim, since it now excludes the random discontinuities described as an "important aspect" of Jackson's invention (see col. 2, line 67 to col. 3, line 5). The same holds true for dependent claims 3-5, 11, 12, and 22.

In the struggle to show that a "regular" surface is present, the Examiner points to the portion of Jackson describing a "smooth, continuous, aesthetically pleasing

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308 F.3d 1193, 1203, 64 USPQ2d 1812 (Fed. Cir. 2002) ("Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.").

appearance" (Office Action, ¶ 1(b), p. 4). (Emphasis in Original). This specious attempt to equate a "regular" surface with a "continuous" appearance must fail, since the two notions are clearly mutually exclusive. Viewed from the Earth, the surface of the Moon undoubtedly has a "continuous" or uninterrupted appearance, even though the surface is actually quite irregular and discontinuous. Accordingly, not only does this statement *per se* fail to meet the terms of Applicant's "regular surface" limitation when properly construed, but it must also be understood in the context of the other teachings of Jackson, which very clearly describe surface "discontinuities . . . randomly distributed throughout the coating" (Abstract). Simply put, Jackson does not disclose the claimed "regular" surface, since any references to "smooth" or "continuous" must necessarily be interpreted in light of the desirability for the random discontinuities now excluded from claim 1.

Turning to claim 23, it is rejected as anticipated by Jackson. However, the Examiner cites to nothing in this reference that discloses the claimed "layer of paint roller-applied" to a thermoplastic polymer coating, which in turn is applied to the outer side of a non-woven fiber tissue or mat. Moreover, nowhere in the Office Action is the contention made that any combination of references teaches all limitations of claim 23. Accordingly, this claim and its progeny (including dependent claims 24-27 and 31-35) should be immediately held allowable.

Although the indefiniteness rejection is withdrawn, the Examiner also repackages and represents the corresponding argument that the "regular" limitation is not "defined by the claims or specification" (Office Action, ¶ 1(a), p. 2). Applicant respectfully submits that the specification need not expressly define the terms used in the claims. Rather, acceptability of the claim language depends on the understanding of a skilled artisan in light of the specification.

Here, a skilled artisan would understand perfectly what is meant by a "regular" surface in claims 1 and 23 in light of the teachings of the accompanying specification, regardless of the absence of any express definition. Nothing in the present record suggests

otherwise. Contrary to the Examiner's suggestion, there is simply no requirement in the law that the Applicant expressly define the terms used in the specification or claims.

The contention is also made that Applicant's arguments are "contradictory to their Specification, which discloses that the polymeric material has a degree of gas permeability" (Office Action, ¶1(b), p. 3). Nowhere does the Applicant argue that the claimed polymeric material lacks gas permeability. Again, a regular surface can be gas permeable, just like one that has a "continuous" appearance. There is no inconsistency whatsoever.

Notwithstanding the allowability of claims 1 and 23 over Jackson, several of the dependent claims also patentably distinguish over this reference. For example, dependent claims 5 and 27 require that the thermoplastic polymer coating comprises a matrix polymer resin selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and combinations thereof. Withdrawing the prior admission made that Jackson "fails to explicitly disclose the use of polyethylene and polypropylene resins," the Examiner nevertheless contends that this patent anticipates claims 5 and 27 because "the use of resins such as polyethylene in plastisol to produce a coating material is known in the art" (Office Action, ¶5, p. 6).

A finding of anticipation is proper "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single prior art reference*" Section 2131 MPEP, ch. 2100, p. 73. (Emphasis Added). "Normally, only one reference should be used" in making an anticipation rejection. Section 2131.01 MPEP, ch. 2100, p. 73. However, reliance on a second reference in support of an anticipation rejection has been held proper when it is cited to: (1) prove the primary reference contains an enabled disclosure; (2) explain the meaning of a term used in the primary reference; or (3) show that a characteristic not disclosed in the reference is inherent. Section 2131.01 MPEP, ch. 2100, p. 74.

Despite the withdrawal of the express admission, an implicit admission remains that Jackson does not disclose "each and every element of the claim" as required for a proper anticipation rejection. Nevertheless, reliance on a second reference, WO 95/079946

is made to show that "the use of resins such as polyethylene in plastisol form to produce a coating material is known in the art." That the use of polyethylene in plastisol form is "known in the art" is entirely irrelevant to the consideration of whether Jackson anticipates claims 5 or 27. Applying the Examiner's logic, no patent would ever issue on a species in combination with another structure simply because the genus without the combination is "known in the art," which simply cannot be the case. Rather, the proper consideration is whether "each and every element as set forth in the claim is found, either expressly or inherently described" in Jackson. Since the Examiner admits that such is not the case, the rejections of these claims cannot stand. The Examiner also fails to address or explain the relevance of WO 95/079946 to Applicant's field of endeavor, which makes it non-analogous (and presumably why the Examiner relies on anticipation instead of obviousness).

Finally, dependent claim 35 requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion comprising of ground calcium carbonate and ground titanium dioxide in high density polyethylene. Applicant finds no such disclosure anywhere within the four corners of Jackson, nor is such a teaching provided by WO 95/07946. Accordingly, the anticipation rejection made is improper and must be withdrawn.

Summarizing the foregoing, none of claims 1, 3-5, 11-12, 22-27 and 31-35 is anticipated by Jackson (which cannot properly be combined with WO 95/07946 in support of such rejections). Reconsideration of these claims is thus respectfully requested.

**Rejection of Claims 1, 3-5, and 11-12 under 35 U.S.C. §102(e)**

Claims 1, 3-5, and 11-12 are rejected as being anticipated by Gundberg et al. (U.S. Patent No. 6,203,646). Applicant respectfully traverses the Examiner's rejection.

As previously noted, Gundberg et al. discloses a fibrous thermoplastic netting layer adhered around at least a part of the surfaces of a mineral fiber base layer for use as thermal and acoustic insulation (see Column 1, lines 18-19 and Column 9, lines 50-51). As

shown in Figure 1, a netting 13 of fibers or filaments 11 of thermoplastic is deposited on the surface of a mineral fibre web 12. (Emphasis added) Alternatively, in another preferred embodiment, as shown in Figure 3 and described in Column 7, beginning at line 1, a polymer melt in the form of fibres or filaments 36 is dispensed from pressure guns 35 on the upper side of a mineral fibre web 37 so as to form a coherent netting 38. (Emphasis added). The surface coating is added in Gundberg et al. to increase the tactility of the mineral fiber material during handling, and thus is limited to a surface weight between 2 and 50 g/m<sup>2</sup>. The surface coating is also added to impart additional strength to the fibers. Further, as stated in Example 1 (col. 8, line 16), the surface coating had the appearance of a non-woven material. (Emphasis added)

The present invention, on the other hand, as set forth in claim 1 and dependent claims 3-5 and 11-12, describes a polymeric wall covering material, not an insulating material, having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular roller paintable visible outer surface substantially free from random discontinuities susceptible to creating irregularities when the surface is roller painted. (Emphasis added). The thermoplastic coating is added to the non-woven material to reduce the amount of paint necessary to impart a smooth surface on the wall covering, not to improve the strength and tactility of the underlying fibers. Moreover, the coating is regular, which is contrasted from the netting having the appearance of the underlying non-woven material that results in the Gundberg et al. approach.

As one of ordinary skill appreciates, a regular, visible outer surface would allow for the application of paint using a roller, therein improving the aesthetic characteristics of the fiber reinforced wall covering. Gundberg et al., on the other hand, does not form a regular roller paintable outer surface, but instead forms a netting that has the appearance of a non-woven material (i.e., a coherent netting). Any skilled artisan would appreciate that a netting layer is not easily paintable, especially with a roller applicator. In fact, a roller applicator would not even be considered to paint the thermoplastic netting layer in Gundberg et al., as it would be impossible to paint every surface of the filaments easily. In

fact, the very reason for adding the thermoplastic material in the present invention is to change the surface characteristics of the non-woven material to make it more paintable, especially with a roller applicator, while the thermoplastic in Gundberg et al. maintains a non-woven appearance (see col. 8, ll. 16-17).

As such, claim 1 and dependent claims 3-5 and 11-12 are not anticipated by Gundberg et al. Reconsideration of the rejections is thus respectfully requested.

**Rejection of Claims 2, 8, and 30 under 35 U.S.C. §102(b)/35 U.S.C. §103(a)**

Claims 2, 8, and 30 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Jackson et al. Turning first to dependent claim 2, it requires that the roller paintable, visible outer surface of the thermoplastic polymer coating has a surface tension of at least approximately 30 dynes/cm. The Examiner expressly acknowledges that Jackson is completely silent as to the claimed surface tension, but nevertheless contends that it is "reasonable to presume" that the "claimed properties" are "inherent" in the material disclosed in this reference, without providing any explanation as to why such might be the case.

This naked assertion is contrary not only to the Manual of Patent Examining Procedure, but also precedential Federal Circuit decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."<sup>2</sup> Not only do the steps described for forming the Applicant's claimed wall covering material differ completely from those outlined in the Jackson patent, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. Jackson is completely silent as to the surface tension of the substrate or any steps taken to alter it.

With regard to the Examiner's citation of authority, Applicant notes that the proposition for which the cases are advanced does not apply on the present facts. The

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<sup>2</sup> See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.



dated decisions of In re Fitzgerald, 205 USPQ 594 (CCPA 1980) and In re Best, 195 USPQ 433 (CCPA 1977) stand for the proposition that where "claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." Id. (Emphasis added). Here, Applicant has demonstrated that the products are not identical or substantially identical, and they are clearly not produced using identical or substantially identical processes, since Jackson fails to mention any corona discharge treatment. Thus, the holdings of these decisions are inapposite.

In final analysis, it is unreasonable and, in fact, wholly irrational to simply "presume" that the same end product would result, including one having the claimed surface tension. The same holds true with respect to the water vapor transmission rates of claims 8 and 30. Accordingly, the rejections of these claims based on the teachings of Jackson are improper and should be withdrawn.

#### Rejection of claim 2 under 35 U.S.C. §102(e)/ §103(a)

Claim 2 stands rejected under 35 U.S.C. §102(e) or, alternatively, under §103(a). As described above, claim 1 is not anticipated by Gundberg et al. As such, dependent claim 2 is similarly not anticipated by Gundberg.

Nonetheless, as indicated above, the fibrous thermoplastic netting layer adhered to a mineral fiber base layer in Gundberg et al. is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers by providing a netting over the fibers themselves. The coating also helps to minimize the release of fibre wads or single fibers to the surroundings before, during and after mounting. It does not create a regular paintable surface, especially a surface that can be easily painted with rollers, as in the present invention. Moreover, the insulator disclosed in Gundberg et al. is formed using a completely different process, so it is again unreasonable to presume that the claimed surface tension is "inherent."

Claim 2 is therefore neither anticipated by nor obvious in view of the cited prior art. Reconsideration of claim 2 is respectfully requested.

**Rejection of claim 6 and 7 under §103(a)**

Claims 6 and 7 stand rejected as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, as applied to Penz et al. Applicant respectfully traverses the Examiner's rejection.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."<sup>3</sup> One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.<sup>4</sup>

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber.

It would not be obvious to combine the teachings of Gundberg et al. and Penz et al. to arrive at the present invention. No reason is shown why one of ordinary skill in the art

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<sup>3</sup> *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

<sup>4</sup> *In re Fine*, 837 F.2d at 1075.

would modify Gundberg et al. as the Office Action proposes. Here, the Examiner is utilizing Penz et al. to include a mineral filler in the chemical composition of the polymeric fiber coating of Gundberg et al. as is presented in claims 6 and 7. This would result, in Gundberg et al., in mineral filler containing polymeric material in strand or filament form coupled to the non-woven mat structure in the form of a net coating (which again, is in stark contrast to the regular, roller paintable outer surface claimed). Applicant respectfully suggests that there would be no motivation to combine Gundberg et al. and Penz et al. to arrive at the present invention as in present claims 6 and 7, as the addition of mineral filler to the composition of Gundberg et al. would still not result in a paintable outer surface (especially with a roller applicator) for a wall covering material as in claims 6 and 7.

Hence claims 6 and 7 are not obvious in view of the cited prior art. Reconsideration of claims 6 and 7 is respectfully requested.

**Rejection of claim 6, 7 and 28-29 under §103(a)**

Claims 6, 7 and 28-29 stand rejected as being unpatentable over Jackson in further view of Penz et al. (with further citation to Gundberg et al.) Applicant respectfully traverses these rejections.

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. It would not be obvious to combine Jackson and Penz et al. to arrive at the present invention, since there is no motivation to do so. Again, the Examiner is utilizing Penz et al. to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface, when in fact Jackson specifically teaches that such is not desirable. These references are simply not properly combinable, and even when combined do not lead to the claimed invention.

**Rejection of claim 9, 10, 13 under 35 U.S.C. under §103(a)**

Claims 9, 10 and 13 stand rejected as being unpatentable over Gundberg et al., as

applied to claims 1, 3-5, and 11-12 above, and further in view of Melber et al. Applicant respectfully traverses the Examiner's rejection.

Melber et al. discloses a method for making an opaque coating comprising employing opacifiers into or onto the surface of thermoplastic microspheres.

It would not be obvious to combine the teachings of Gundberg et al. and Melber et al. to arrive at these inventions. No reason is shown why one of ordinary skill in the art would modify the Gundberg et al. as the Office Action proposes. As stated previously with regards to mineral fillers, the addition of an opacifying agent of Melber et al. to the polymeric netting coating of Gundberg et al. would still not result in a roller paintable outer visible surface of a polymeric wall covering material as in claims 9, 10 and 13. As such, there would be no reason to combine the opacifying enhancement characteristics described in Melber et al. with Gundberg et al. to arrive at claims 9, 10 and 13 as proposed.

Hence, claims 9, 10 and 13 are not obvious in view of the cited prior art. Reconsideration of claims 9, 10 and 13 is respectfully requested.

#### **Formal Amendments and New Claim 36**

Finally, Applicant presents formal amendments to independent claims 23 and 26, as well as new claim 36, for consideration. This new claim reads on a fiber reinforced polymeric wall covering material comprising a rigid non-woven fiber tissue or mat having an inner side and an outer side. A thermoplastic polymer coating is applied to the outer side of the rigid non-woven fiber tissue or mat. Support for this claim is found in the second paragraph on page seven of the application as filed.

Since none of the cited patents teach a fiber reinforced polymeric wall covering material comprising non-woven rigid fiber tissue or mat having a thermoplastic polymer coating, this claim is believed to distinguish over all cited prior art and thus should be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13 and 22-36 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167 if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

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